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In re application of

Didier Arnoux et al.

Serial No. 09/868,289

Filed: July 10, 2001

For: THERMOSETTING POLYURETHANE/UREA-FORMING COMPOSITIONS

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: DECISION ON
: PETITION
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This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed December 19, 2005.

On November 2, 2005, a final office action was mailed to Applicants, rejecting all of the pending claims under 35 USC 102 or 35 USC 103 and 35 USC 112 1st paragraph. Applicants responded to this office action with an amendment after final which was filed on December 19, 2005. The examiner refused entry of the amendment in an advisory action mailed January 4, 2006.

On March 31, 2006, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment of December 19, 2005.

Petitioner's position is that the amendment after final does not raise any new issues as alleged by the examiner in the advisory action and that the amendment further reduces the issues for appeal.

DECISION

Section 714.13 of the MPEP states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection. An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions. See also MPEP § 1206 and § 1211.

ACTION BY EXAMINER

See also MPEP § 706.07(f).

In the event that a proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for nonentry should be concisely expressed. For example:

- (A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
- (B) The claims, if amended as proposed, would raise the issue of new matter.
- (C) The claims as amended present new issues requiring further consideration or search.
- (D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Section 714.20 of the MPEP states :

List of Amendments Entered in Part

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. At times, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for reply. Thus:

- (A) An "amendment" presenting an unacceptable substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry in toto. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been entered. See 37 CFR 1.125 and MPEP § 608.01(q) for information regarding the submission of a substitute specification. Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A proper substitute specification will normally be accepted by the Office even if it has not been required by the examiner. However, entry of a substitute specification filed after the notice of allowance has been mailed (37 CFR 1.312) is not a matter of right.
- (B) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See MPEP § 714.16(e).
- (C) In an application in which prosecution on the merits is closed, i.e., after the issuance of an *Ex Parte Quayle* action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the

opinion of the examiner not patentable, or will require a further search, the amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution.

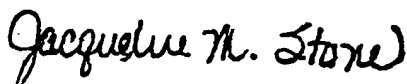
(D) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted.

In the final rejection mailed November 2, 2005, all of the claims were rejected under 35 USC 102 or 103 and 35 USC 112 1st paragraph. In the after final amendment filed December 19, 2005, Applicants attempted to cancel claims 33, 39, 41, 43, 45, and 49 and amend the dependency of claims 34-38, 40, 44, and 46-48 to newly depend from independent claim 50. The examiner stated in the advisory action that such an amendment would raise a new issue that would require a further search and/or consideration as independent claim 50 contained an additional component (c) which had not been searched or considered in combination with dependent claims 34-38, 40, 44, and 46-48, as required by the proposed amendment.

Petitioner argues specifically that the cancellation of claim 49 should be entered because the cancellation of the claim resulted from a new ground of rejection applied to claim 49 in the final rejection and further eliminates the need to appeal the rejection of claim 49. These arguments are not persuasive. After final amendments may not be entered in part; therefore, petitioner's request for the cancellation of claims 33, 39, 41, 43, 45, and 49 alone is improper.

With respect to the amendments to claims 34-38, 40, 44, and 46-48, petitioner argues that the amendment would not raise issues as claim 50 had not been rejected as being obvious over JP 6-16767. However, claim 50 has been rejected on additional grounds in the final rejection. As acknowledged by petitioner, claim 50 is of a different scope than claim 33, upon which claims 34-38, 40, 44, and 46-48 had previously depended. This difference in scope has not been previously considered or addressed by the examiner and, as noted by the examiner in the advisory action, would require further consideration and/or search.

Accordingly, the petition for entry of the after final amendment is **DENIED**.



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